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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197573
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Attachments	11.01.24 Chase's Response to Mtn to Dismiss-More Definite Statement.PDF (9 pages)(55186 bytes) Exh C to Not of Opposition.PDF (1 page)(32309 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Chase Brass & Copper Company, LLC,)	
a Delaware limited liability company,)	
as a licensee of Sambo Copper)	
Alloy Co., Ltd., a Japanese corporation,)	
)	
Opposer,)	Opposition No. 91/197,571
)	Opposition No. 91/197,573
)	Opposition No. 91/197,574
)	
v.)	
)	
Sipi Metals Corp., an Illinois corporation,)	
)	
Applicant.)	

**CHASE’S RESPONSE TO APPLICANT’S MOTION TO DISMISS
AND MOTION FOR A MORE DEFINITE STATEMENT**

On January 3, 2011, Sipi Metals Corp. (hereinafter “Applicant”) filed a Motion to Dismiss and a Motion For a More Definite Statement. Opposer, Chase Brass & Copper Company, LLC (“Chase”), by and through its attorneys, responds to Applicant’s Motion to Dismiss and a More Definite Statement (“Applicant’s Motion”) as follows:

A. STATEMENT OF FACTS

1. ECO BRASS and ECOBRASS Registered Marks

On May 26, 1999, Sambo Copper Alloy Co., Ltd. (hereinafter “Sambo”) filed U.S. Trademark Application Serial No. 75/716,107 for ECOBRASS for “copper and copper alloy in bars, billets and sheets for use in future manufacturing by machining, casting or forging” in International Class 6. See Exhibit B to Chase’s Notice of Opposition. U.S. Trademark Application Serial No. 75/716,107 proceeded to registration on August 7, 2001 as U.S. Trademark Registration No. 2,474,958. *Id.* Sambo also filed U.S. Trademark Application Serial No. 75/741,530 for ECO BRASS for “copper alloy in

the nature of brass in bars, billets and sheets for use in future manufacturing by machining, casting and forging” in International Class 6. *See* Exhibit C¹ to Chase’s Notice of Opposition. U.S. Trademark Application Serial No. 75/741,530 proceeded to registration on August 21, 2001 as U.S. Trademark Registration No. 2,479,029. *Id.*

2. Chase Is a Licensee of Sambo and Has Standing to Oppose.

In 2005, Chase obtained exclusive rights for the production and sale of ECO BRASS rod and ingot in North America. ECO BRASS is a “lead-free” brass material commercially developed by Sambo. In 2005, Sambo also granted a license to use U.S. Trademark Application Serial No. 75/716,107 for ECOBRASS and U.S. Trademark Application Serial No. 75/741,530 for ECO BRASS. *See* Notice of Opposition, at ¶ 4. For ease, ECO BRASS and ECOBRASS are referred to hereinafter as ECO BRASS.

3. Chase Has Been Using ECO BRASS In Interstate Commerce Since 2005.

Since 2005, Chase has been using ECO BRASS in interstate commerce. *See* Notice of Opposition, at ¶ 5. Chase uses ECO BRASS on copper alloy in rods for use in, among other things, manufacturing by machining, casting and forging. *See* Notice of Opposition, at ¶ 5.

4. Applicant’s Intent-to-Use Applications for the ECO BRONZE Marks

On March 1, 2010, Applicant filed 3 intent to use applications (collectively “the ECO BRONZE marks”):

¹ Exhibit C was filed in Opposition Nos. 91/197,574 and 91/197,573. Although, Opposer referenced Exhibit C in Notice of Opposition No. 91/197,571, Exhibit C does not appear on TTABVue in Notice of Opposition No. 91/197,571. Accordingly, for completeness, Opposer re-attaches herein Exhibit C to the Notice of Opposition.

- U.S. Trademark Application Serial No. 77/947,606 (“the ‘606 Application”) for ECOBRONZE for “bronze and bronze alloy in bars, billets and sheets for use in manufacturing by machining, casting or forging” in International Class 6;
- U.S. Trademark Application Serial No. 77/947,618 (“the ‘618 Application”) for ECO BRONZE for “bronze and bronze alloy in bars, billets and sheets for use in manufacturing by machining, casting or forging” in International Class 6; and
- U.S. Trademark Application Serial No. 77/947,614 (“the ‘614 Application”) for ECO-BRONZE for “bronze and bronze alloy in bars, billets and sheets for use in manufacturing by machining, casting or forging” in International Class 6.

See Exhibit A to Chase’s Notice of Opposition; *see also* Notice of Opposition, at ¶ 1.

5. Chase Opposed the ECO BRONZE Marks For False Suggestion, Likelihood of Confusion and Dilution.

On November 24, 2010, Chase, as the exclusive licensee of product from Sambo, licensee of ECO BRASS, and continual user of ECO BRASS, filed a Notice of Opposition to prevent registration of the ECO BRONZE marks. Chase set forth its prior use of ECO BRASS. *See* Notice of Opposition, at ¶ 6. Chase asserted its goods marketed and sold under ECO BRASS are similar to the recitation of goods in Applicant’s 3 ECO BRONZE trademark applications (implying the same channels of trade and customers). *See* Notice of Opposition, at ¶ 5. Chase also asserted the ECO BRONZE marks and ECO BRASS are confusingly similar, as ECO BRASS and ECO BRONZE are very similar in appearance, sound and connotation. *See* Notice of Opposition, at ¶ 8. Furthermore, Chase asserted registration of the ECO BRONZE marks will damage and injure Chase and ECO BRASS. *See* Notice of Opposition, at ¶ 8. Chase plead that the ECO BRONZE marks are likely to “cause confusion or mistake in the

minds of the public and lead the public and prospective purchasers to believe that applicant's goods are those of Sambo and/or Chase." *See* Chase's Notice of Opposition, ¶ 8.

Additionally, Chase plead that registration and use of the ECO BRONZE marks will lead the public and prospective purchasers to believe that Applicant's goods are endorsed, sponsored, or otherwise affiliated or connected with Chase, and all to the damage and injury of the purchasing public and to the damage and injury of Sambo and Chase. *See* Chase's Notice of Opposition, ¶ 8.

Furthermore, Chase plead that the grant of a registration to Applicant for the ECO BRONZE marks should be denied on the grounds that Applicant's use and registration of the ECO BRONZE marks dilutes the distinctiveness of ECO BRASS, under 15 U.S.C. §1125(c). *See* Chase's Notice of Opposition, ¶ 9. Chase also properly asserted that the ECO BRASS mark is famous. *See* Chase's Notice of Opposition, ¶ 9.

B. ARGUMENT

In response to Chase's Notice of Opposition, Applicant filed: (1) a Motion to Dismiss Chase's alleged claims under Trademark Act Section 2(a); (2) a Motion to Dismiss Chase's dilution claim under 15 U.S.C. §1125(c); and (3) a Motion for More Definite Statement of Chase's claim under Trademark Act Section 2(d). Chase submits that it has plead facts sufficient to support a Section 2(a) claim. Although Chase may have standing to assert a dilution claim and Chase properly plead the fame and interstate commerce elements, Chase will voluntarily dismiss the dilution claim to advance the Opposition. Thus, Applicant's motion to dismiss Chase's dilution claim under 15 U.S.C. §1125(c) is moot. Furthermore, Chase properly plead with sufficient detail its likelihood

of confusion claim under Section 2(d), so much so that Applicant was able to answer and even counterclaim. Thus, Applicant's Motion for a More Definite Statement of Chase's claim under Section 2(d) should be denied.

1. Chase Did Properly Plead Section 2(a) As a Ground of Opposition.

"A notice of opposition must include (1) a **short and plain statement** of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark....and (2) **a short and plain statement** of one or more grounds for opposition." *See* Trademark Trial and Appeal Board Manual of Procedure (TTABMP) § 309.03(a)(2) (emphasis added). Chase provided a clear statement of opposition to registration of the ECO BRONZE marks by stating that registration and use of the ECO BRONZE marks will "lead the public and prospective purchasers to believe that applicant's goods...are endorsed, sponsored, or otherwise affiliated or connected with Sambo and/or Chase...and all to the damage and injury of the purchasing public and to the damage and injury of Sambo and Chase." *See* Chase's Notice of Opposition, ¶ 8. Chase also set forth Section 2(a) as a reason for opposing the ECO BRONZE marks in the TTAB electronic paperwork associated with filing a Notice of Opposition.

Section 2(a) prohibits registration of a mark that "...may disparage or falsely suggest a connection with persons..." According to Trademark Act §45, the term "persons" includes a corporation, like Chase. The Board has set forth the following 4 elements for denying registration under Section 2(a):

- (i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- (ii) that the mark would be recognized as such;

- (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and
- (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.

Applicant states that “Opposer does not plead that ECO BRONZE / ECO-BRONZE / ECOBRONZE has any connection with a name or an identity, much less the identity of Opposer.” *See* Applicant’s Motion, p. 3. However, satisfying element (i), Chase asserted that it used and continues to use ECO BRASS, long before Applicant’s intent-to-use applications for the ECO BRONZE marks, and “[t]he mark[s] sought to be registered by Applicant [are] confusingly similar to the ECO BRASS mark”. Satisfying element (ii), Chase asserted that the public and perspective purchasers would recognize the similarity of the ECO BRONZE marks and ECO BRASS, and falsely associate the ECO BRONZE marks and products with Chase. *See* Notice of Opposition, ¶ 8 (“use of ECO BRONZE by Applicant is likely to ... lead the public and prospective purchasers to believe that applicant’s goods are those of Sambo and/or Chase or are endorsed, sponsored, or otherwise affiliated or connected with Sambo and/or Chase.”); *see also See Buffet v. Chi-Chi’s Inc.*, 226 USPQ 428 (TTAB 1985) (MARGARITAVILLE for restaurant services falsely suggests a connection to Jimmy Buffett).

Furthermore, Applicant does not assert that Chase failed to satisfy elements (iii) and (iv). The Opposition itself implies that Sipi is not connected with Chase or any of its products – although, if Sipi is allowed to register the ECO BRONZE marks, the public

may believe there is an association. Sipi also does not contest that Chase and ECO BRASS are of sufficient fame or reputation for Section 2(a).

Accordingly, Applicant improperly concludes that “the pleading or any associated fact simply fails to support any Section 2(a) claim.” *See* Applicant’s Motion, p. 4. For the reasons stated above, Chase has properly set forth clear and concise statements supporting its Section 2(a) claim and Chase requests the Board deny Applicant’s Motion to Dismiss Chase’s opposition under Section 2(a).

2. Applicant’s Motion to Dismiss the Dilution Claim Under 15 U.S.C. §1125(c) Is Moot.

Although Chase contends that it properly plead in the Notice of Opposition that the ECO BRONZE marks will dilute ECO BRASS, Chase will voluntarily dismiss its dilution claim under §1125(c) to advance the Opposition. Accordingly, Applicant’s Motion to Dismiss Chase’s dilution claim under §1125(c) is moot.

3. Chase Properly Plead Likelihood of Confusion Under Section 2(d).

According to TTAB Manual of Procedure §505.01 (emphasis added), “[a] motion for more definite statement is appropriate **only** in those cases where the pleading states a claim upon which relief can be granted, but is **so vague or ambiguous that the movant cannot make a responsive pleading** in good faith or without prejudice to itself.” Applicant filed a response and counterclaim to the Notice of Opposition. Accordingly, Applicant’s Motion for More Definite Statement was not, and is not, necessary.

Furthermore, “[p]ursuant to Section 2(d) of the Act, 15 U.S.C. § 1052(d), plaintiff must **assert, and then prove at trial**, that defendant’s mark, as applied to the goods or services, so resembles plaintiff’s previously used or registered mark...as to be likely to

cause confusion, mistake, or deception.” TTAB Manual of Procedure §309.03(c) (emphasis added). Chase provided:

- (a) citation to the registered marks it licenses from Sambo (Notice of Opposition, ¶¶ 2 and 3);
- (b) Chase’s prior-continuous-use (2005) of ECO BRASS, as Chase’s use obviously predates Applicant’s intent-to-use application filing date of March 1, 2010;
- (c) description of goods sold and marketed by Chase using ECO BRASS (Notice of Opposition, ¶ 5); and
- (d) the goods set forth in Applicant’s trademark application for the ECO BRONZE marks (Notice of Opposition, ¶ 1), which are very similar to Chase’s goods sold and marketed under ECO BRASS.

Chase plead that the ECO BRONZE marks, as applied to the goods set forth in the application, would likely cause confusion or mistake with Chase or Chase’s goods marketed and sold under the mark ECO BRASS. *See* Notice of Opposition, ¶ 8. Even if Applicant had not admitted clarity by filing a responsive pleading (including a counterclaim), the facts set forth in the Notice of Opposition and Chase’s clear assertion of 15 U.S.C. § 1052(d), meets the pleading standard for a likelihood of confusion claim under Section 2(d). Accordingly, Applicant’s Motion for a More Definite Statement should be denied.

WHEREFORE, Chase respectfully requests the Board to:

1. Deny Applicant’s Motion to Dismiss the opposition to registration under Section 2(a);

2. Render moot Applicant's Motion to Dismiss opposition to registration under 15 U.S.C. §1125(c);
3. Deny Applicant's Motion for a More Definite Statement;
4. Proceed with the instant Opposition as currently scheduled; and
5. Such other relief as the Board deems just and proper.

Dated: January 24, 2011

Respectfully submitted,

By: /s/ Molly B. Edwards

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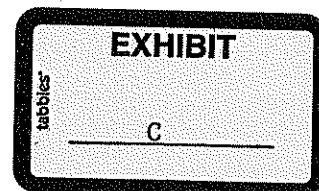
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served via U.S. Mail, postage fully pre-paid, on this 24th day of January, 2011, upon the following:

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Int. Cl.: 6

Prior U.S. Cls.: 2, 12, 13, 14, 23, 25 and 50

United States Patent and Trademark Office

Reg. No. 2,479,029

Registered Aug. 21, 2001

**TRADEMARK
PRINCIPAL REGISTER**

ECO BRASS

**SAMBO COPPER ALLOY CO., LTD. (JAPAN
CORPORATION)
8-374, SAMBO-CHO
SAKAI-SHI, OSAKA-FU, JAPAN**

**FOR: COOPER ALLOY IN THE NATURE OF
BRASS IN BARS, BILLETS AND SHEETS FOR USE
IN FUTURE MANUFACTURING BY MACHINING,
CASTING AND FORGING, IN CLASS 6 (U.S. CLS. 2,
12, 13, 14, 23, 25 AND 50).**

FIRST USE 1-26-2000; IN COMMERCE 1-26-2000.

**NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "BRASS", APART FROM THE
MARK AS SHOWN.**

SER. NO. 75-741,530, FILED 6-30-1999.

KATHLEEN KOLACZ, EXAMINING ATTORNEY